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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,065	12/19/2001	Ghita Lanzendorfer	Beiersdorf 758-WCG	8343

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EXAMINER	
COTTON, ABIGAIL MANDA	
ART UNIT	**PAPER NUMBER**
1617	

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/025,065	LANZENDORFER ET AL.	
	Examiner	Art Unit	
	Abigail M. Cotton	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *Decision mailed by BPAI on 8/31/2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 3-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 3-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

A decision by the Board of Patent Appeals and Interferences reversing the rejections of record was mailed on August 31, 2006. This office action is intended to re-open prosecution to address matters that were raised by the Appeals Board for consideration by the Examiner. Claims 1 and 3-8 are pending in the application.

With regards to the standard procedure following a decision by the BPAI, it is noted that, according to 37 C.F.R. 1.198:

> "[w]hen a decision by the Board of Patent Appeals and Interferences on appeal has become final for judicial review, prosecution of the proceeding before the primary examiner will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or § 41.50 of this title without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown."

Thus, prosecution should not be reopened or reconsidered following a BPAI decision without a showing of sufficient cause.

The Examiner notes that the Appeals Board specifically directed the Examiner in the decision mailed August 31, 2006 to further review the prior art with regards to the uses known in the art of the Aristoflex AVC taught by Loffler. In particular, the Board stated "we encourage the examiner to step back and reconsider the invention together with the available prior art to determine why a person of ordinary skill in the art at the

time of appellant's invention would include Artistoflex AVC in a composition such as that described by Löffler. For illustrative purposes, we direct the examiner's attention to Weihofen[3], which teaches the use of Aristoflex AVC as a thickener" (see page 6 of Decision mailed August 31, 2006.) The Examiner has considered the prior art teachings as directed, and finds that sufficient grounds do indeed exist to reject the instant claims over Loffler in combination with the Weihofen article. Thus, it is deemed that sufficient cause exists to re-open prosecution in the case.

The claims are being newly rejected as follows.

Claim Objections

Claim 6 is objected to because it depends from a claim that has been canceled, namely claim 2. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 and are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,489,395 to Loffler et al. in view of the article entitled "'Hydrafresh' with the Right Polymer" by Dr. Rainer Weihofen, Clariant, February 2001.

Loffler teaches emulsions that can be of the oil-in water type, and that are suitable for the formation of lotions and creams for the application to skin (see abstract, column 4, lines 19-30 and column 5, lines 20-25, in particular), and thus teaches a cosmetic or dermatological emulsion of the oil-in-water type, as recited in claim 1. Loffler teaches that the emulsions can comprise a nonaqueous phase having emulsifiers and oil substances (lipid phase) comprising from 5 to 95% by weight, preferably 15 to 75% by weight (see column 3, lines 55-65, in particular), which overlaps with the amount of the lipid phase recited in the claim. Loffler et al. also teaches that the emulsion can comprise from 5 to 95%, preferably from 25 to 85% by weight of a water phase (see column 3, lines 55-65, in particular), which overlaps with the amount of the water phase as claimed. Loffler et al. teaches that the emulsions can comprise

oligoesters as emulsifiers (see abstract, in particular), in an amount of from 0.1 to 5% by weight (see column 3, lines 53-57, in particular), and thus teaches providing an amount of emulsifiers that overlaps with the amount as recited in the claim. Loffler et al. also teaches that the composition can comprise auxliaries and additives in an amount of 1 to 10% by weight (see column 5, lines 15-17, in particular), which overlaps with the amount of the copolymer as recited in claim 9.

Furthermore, it is considered that one of ordinary skill in the art at the time the invention was made would have found it obvious to vary and/or optimize the amount of the lipid phase, water phase, emulsifiers or auxiliaries provided in the composition, according to the guidance provided by Loffler, to provide a composition having desired properties, such as a desired emulsification stability, or a desired auxiliary property. It is noted that "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955.)

Loffler further provides examples of oil-in-water cosmetic formulations having water phase, lipid phase, and emulsifiers that are within the claimed range. For example, the oil-in-water cream of Example 3 has a POLYESTER 1 corresponding to the emulsifying oligoester in an amount of 1.5% by weight, which meets the limitation of the amount of the emulsifiers recited in the claim, with a total amount of the lipid phase (POLYESTER 1 + mineral oil + isopropyl palmitate + Eutanol G) being 17.5%, which

meets the limitation of the amount of the lipid phase, as recited in the claim. The composition furthermore has a water phase (water + preservative) of 81.40%, which is within the range as recited in claim 9 (see Example 3, column 6, lines 20-30, in particular.) Accordingly, Loffler clearly exemplifies cosmetic oil-in-water compositions having the parts (i)-(iii) as recited in claim 9.

Loffler also exemplifies the compositions, including that of Example 3, having Aristoflex AVC, which is an ammonium acryloyldimethyltaurates/vinylpyrrolidone copolymers, in an amount of 0.70 or 0.60% by weight (see Examples 1-7, column 5, line 50 through column 7, line 35, in particular.)

Loffler does not specifically teach providing the Aristoflex AVC polymer in an amount of from 0.2% to 0.3% by, as recited in claim 9. Loffler also does not teach or suggest the function Aristoflex AVC polymer in the emulsion, and thus does not provide motivation to one of ordinary skill in the art to vary the amount of the Aristoflex AVC polymer to achieve the amount as claimed.

Weihofen teaches that small quantities of Aristoflex AVC can be to emulsions added, even at amounts of less than 1%, to produce a stable cream or lotion with desired consistencies (see page 33, first full paragraph, in particular), and teaches that Aristoflex AVC can be used as a rheology modifier in the place of other thickeners (see page 33 first through third full paragraphs, in particular.) Thus, Weihofen teaches that

small amounts of Aristoflex AVC, i.e. less than those exemplified by Loffler, can be provided to stabilize emulsions as well as to provide a desired rheology and consistency.

Accordingly, it is considered that one of ordinary skill in the art at the time the invention was made would have found it obvious, based on the teachings of Weihofen, to modify the amount of Aristoflex AVC provided in the compositions of Loffler et al, because Loffler teaches the oil in water emulsions as claimed, and having Aristoflex AVC provided in an amount that is slightly above that being claimed, whereas Weihofen teaches that the amount of Aristoflex AVC provided in a composition can be desirably selected according to the stability requirements and preferred rheology and consistency of the oil in water compositions, and that an amount of the Aristoflex AVC provided can be as low as less than one percent. Thus, it is considered that one of ordinary skill in the art would have been motivated to modify and/or optimize and/or reduce the amount of Aristoflex AVC provided in the compositions of Loffler et al, with the expectation of providing desired rheology and consistency of the compositions, as well as with the expectation of imparting stability to the compositions, since Weihofen teaches that even less than about 1percent of the compound can be beneficially used. Accordingly, claim 1 is obvious over the teachings of Loffler in view of Weihofen.

Regarding claims 3 and 6, Loffler teaches that the amount of the nonaqueous (lipid) phase can be from 5 to 95% by weight (see column 3, lines 58-65, in particular),

which overlaps with the amount as claimed. Loffler et al. also exemplifies compositions having lipid phases in an amount of 17.5% (see Example 3, in particular), and 16% (see Example 5, in particular), which are amounts that are close to the upper range limits of 7.5%, as in claim 3, and 10%, as in claim 6. Furthermore, it is considered that one of ordinary skill in the art at the time the invention was made would have found it obvious to vary and/or optimize the amount of the lipid phase provided in the composition, according to the guidance provided by Loffler, to provide a composition having desired properties, such as desired stability and skin feel. It is noted that "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955.)

Regarding claims 4-5 and 7-8, Loffler teaches that the emulsions can comprise auxiliaries such as dyes, which can be provided in an amount of from 1 to 10% by weight, such as 2 to 5% by weight, which is an amount that meets the limitations of the claims (see column 5, lines 1-17, in particular.)

Conclusion

No claims are allowed.

The PTO 892 form accompanying this office action lists the prior art made of record and not relied upon that is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abigail M. Cotton whose telephone number is (571) 272-8779. The examiner can normally be reached on 9:30-6:00, M-F. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AMC

SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER